

**REMARKS**

**I. Status of Claims**

Claims 1, 2, 5, 8, 9, 12, 16, 18, 19, 21-24, 26, 36, 40, 45, 71, 73, 77, 79, 82 and 83 are currently pending, with claims 1, 2, 5, 8, 9, 12, 18, 19, 21-24, 26, 36, 40, and 45 under current examination, and claims 16, 71, 73, 77, 79, 82, and 83 having been withdrawn from consideration. No amendments are made herein. Accordingly, there is no issue of new matter.

**II. Rejection Under 35 U.S.C. § 103(a)**

The Examiner rejects claims 1, 2, 5, 8, 9, 12, 18, 19, 21-24, 26, 36, 40, and 45 under 35 U.S.C. § 103(a) as allegedly “being unpatentable over” the combination of U.S. Patent No. 3,911,105, to Papantoniou et al. (“the ‘105 patent”) and U.S. Patent No. 5,866,111, to Felardos et al. (“the ‘111 patent”). February 3, 2009, Final Office Action at 2.

The Examiner asserts that the ‘105 patent “teaches cosmetic make up compositions using polystearyl acrylate. This compound is the species of formula II.” Id. The Examiner cites the examples and claims 1-12 and “especially claim 5” of the ‘105 patent to support this assertion. However, the Examiner admits that the ‘105 patent “does not teach the film forming polymer sulfoester.” The Examiner then cites the ‘111 patent to allegedly cure the deficiencies of the ‘105 patent, asserting that the ‘111 patent “teaches the [elected] claimed sulfoester as the film forming ‘polymer.” Id.

Applicants disagree with the Examiner’s assertions and respectfully traverse the Examiner’s § 103(a) rejection for at least the reason that the Examiner has failed to

make a *prima facie* showing of obviousness. Several basic factual inquires must be made in order to determine whether the claims of a patent application are obvious under 35 U.S.C. § 103. These factual inquiries, set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. Graham, 383 U.S. at 17-18, 148 USPQ 467; see also KSR Int'l Co. v. Teleflex, Inc., 127 S. Ct. 1727, 1734 (2007).

The Supreme Court, in the KSR decision, recognized that a showing of "teaching, suggestion, or motivation" could provide helpful insight in determining whether the claimed subject matter is obvious under Section 103(a). KSR, 127 S. Ct. at 1741. In addition, the Supreme Court mandates that "[t]o facilitate review, this analysis [of whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue] should be made explicit." Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

Indeed, to establish a *prima facie* case of obviousness, the Examiner must:

make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the " subject matter as a whole" of the invention.

M.P.E.P. § 2142. "The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." M.P.E.P. § 2143.

The '105 patent discloses "[a] fatty composition for use in producing cosmetic composition[s] comprising a mixture of at least one cosmetic fatty body and at least one non-toxic polymer." '105 patent, Abstract. The '111 patent discloses "cosmetic compositions ... based on at least one film-forming polyester polymer and sugar esters." '111 patent, Abstract. However, the '105 patent and '111 patent do not disclose or suggest Applicants' claimed invention, nor do they provide motivation for one to arrive at the present claims. This is at least because the '105 and '111 patents do not disclose or suggest

[a] cosmetic composition comprising, in a physiologically acceptable medium, at least one first compound which gives the cosmetic composition a thermal profile wherein the melting peak has a mid-height width  $L_f$  less than or equal to 10°C,

wherein the at least one first compound has a thermal profile wherein the melting peak has a mid-height width  $L_f$  less than or equal to 10°C;

wherein said thermal profile is determined by heating an empty crucible and a crucible containing a sample of said composition and measuring the variation of the difference in

power absorbed by the empty crucible and by the crucible containing the sample as a function of temperature, . . .

as recited, in-part, in independent claim 1.

Neither the '105 nor the '111 patents disclose or suggest any requirement for a cosmetic composition to have a thermal profile wherein the melting peak has a mid-height width  $L_f$  less than or equal to 10°C, or that at least one first compound has a thermal profile wherein the melting peak has a mid-height width  $L_f$  less than or equal to 10°C, as required by claim 1. Thus, for both the '105 and the '111 patents, there is no issue of express or inherent anticipation of this feature of claim 1.

In the Final Office Action mailed September 3, 2008, the Examiner asserts that the "PTO is not equipped to determine the claimed desired thermal profile or melting peak, and claimed cosmetic composition comprising . . . at least one compound which gives the cosmetic composition a thermal profile . . ." September 3, 2008, Final Office Action at 4-5. In the present Final Office Action, mailed February 3, 2009, the Examiner alleges that "it would be obvious . . . to prepare a third composition by combining the prior art ingredients." February 3, 2009, Final Office Action at 3. Without making an explicit assertion, and to overcome the '105 and '111 patents' silence regarding this feature of claim 1, the Examiner apparently considers that the claimed thermal profile wherein the melting peak has a mid-height width  $L_f$  less than or equal to 10°C, recited in claim 1, is a resulting property of a combination of the '105 and '111 patents.

In other words, it appears that the Examiner takes the position that the melting peak limitation is an inherent property of the combination of the '105 and '111 compositions.

Applicants acknowledge that M.P.E.P. § 2112 states that inherency may have relevance to obviousness. However, the fountainhead case relied on in the M.P.E.P. is In re Grasselli, 713 F.2d 731,737 (Fed. Cir. 1983), which is relied on in In re Napier, 55 F.3d 610 (Fed. Cir. 1995), also cited in M.P.E.P. § 2112. As seen at page 776 of Grasselli, in rejecting an obviousness argument based on inherency, the court stated:

“If appellant's catalyst is inherent in the Japanese Patent, it has not been established by the record here and obviousness cannot be predicated on that which is unknown.”

As established above, neither the '105 patent nor the '111 patent disclose a composition meeting the thermal profile required by claim 1. The thermal profile required by claim 1 is therefore not necessarily a resulting property of a combination of the compositions taught in the '105 and '111 patents, but rather is necessarily unknown.

And as recognized in the M.P.E.P., Grasselli holds that obviousness cannot be predicated on that which is unknown. Therefore, the rejection under 35 U.S.C. § 103(a) should be withdrawn for that reason.

The '105 and '111 patents also do not disclose or suggest Applicants' claimed invention because they do not disclose or suggest “the at least one amorphous film-

forming polymer is present in an amount greater than or equal to the amount of the first compound," as also recited in independent claim 1. Neither the '105 patent nor the '111 patent disclose or suggest any limitation of a required amount of an amorphous film-forming polymer relative to an amount of a first compound, and certainly not that an amorphous film-forming polymer must be present in an amount greater than or equal to the amount of a first compound, as required by independent claim 1.

The Examiner alleges that "one of ordinary skill in the cosmetic art would discover the optimum range by routine experimentation." February 3, 2009, Final Office Action at 5. Applicants respectfully disagree. M.P.E.P. § 2144.05(II)(B) requires that "[a] particular parameter must first be recognized as a result-effective variable . . . before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." (Citing *In re Antonie*, 559 F.2d 618, 195 U.S.P.Q. 6 (C.C.P.A. 1977) (emphasis added)).

Moreover, even if one of ordinary skill in the art had combined the teachings of the '105 and '111 patents, as proposed by the Examiner, and further had modified the percentages of the at least one amorphous film-forming polymer and the first compound in order to optimize those percentages, it would not have been obvious to modify the percentages such that "the at least one amorphous film-forming polymer is present in an amount greater than or equal to the amount of the first compound," as recited in independent claim 1.

Since the '105 patent does not disclose polystearyl acrylate in its Examples, Applicants refer the Examiner to Example 8 in Table A of the '105 patent. Example 8

discloses the preparation of polystearyl methacrylate, which is used in Examples 18 and 22 of the '105 patent. See the '105 patent, Table A, col. 10, lines 21-45, and col. 11, line 54 through col. 12, line 10. Also, Example 29 of the '105 patent may be modified to use polystearyl methacrylate. See id., col. 14, lines 19-40. In Examples 18, 22, and 29 of the '105 patent, the compositions each have a mass of 100g, and contain 20%, 10%, and 15% polystearyl methacrylate, respectively. See id. The Examiner's proposed combination of the '105 and '111 patents would have to include at least one amorphous film-forming polymer in amounts greater than these percentages in order to disclose or suggest "the at least one amorphous film-forming polymer is present in an amount greater than or equal to the amount of the first compound," as recited in independent claim 1. However, the '111 patent discloses that the film-forming polymer constitutes anywhere from 0.1 to 25% of the compositions of the '111 patent. See the '111 patent, col. 4, lines 36-39. Clearly, the '111 patent does not require that "the at least one amorphous film-forming polymer is present in an amount greater than or equal to the amount of the first compound," as recited in independent claim 1. Thus, for this additional reason, the '105 and '111 patents do not disclose or suggest Applicants' claimed invention as recited in independent claim 1.

The Examiner's proposed combination of the '105 and '111 patents, therefore, does not render the present claims obvious. Thus, the Examiner has not established a *prima facie* case of obviousness with respect to independent claim 1 in view of the '105 and '111 patents, separately or in combination. Independent claim 40, while differing in scope, recites similar limitations as claim 1 and is also allowable over the '105 and '111

patents. Claims 2, 5, 8, 9, 12, 18, 19, 21-24, 26, 36, and 45 are also allowable over the '105 and '111 patents, at least due to their respective dependence from base claim 1 or 40. Applicants therefore respectfully request withdrawal of the rejection of claims 1, 2, 5, 8, 9, 12, 18, 19, 21-24, 26, 36, 40, and 45.

**III. Conclusion**

In view of the above remarks, Applicants respectfully request reconsideration of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By: /Brandon B. Crisp/  
Brandon B. Crisp  
Reg. No. 63,138  
(571) 203-2768